

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARL-LUTZ LAUTERJUNG

MAILED

Appeal No. 2001-1407
Application No. 08/878,908

SEP 13 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21-25, 28 and 63-65. Claims 32, 33 and 36 have been allowed, and the remaining claims have been canceled.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a vascular prosthesis. An understanding of the invention can be derived from a reading of exemplary claim 21, which appears in the appendix to the appellant's Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kwan-Gett	5,151,105	Sep. 29, 1992
Robinson <u>et al.</u> (Robinson)	5,733,325	Mar. 31, 1998
International Patent Application (Lazarus)	WO 89/08433	Sep. 21, 1989

Claims 21-25 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lazarus.

Claims 21-25 and 28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Robinson.

Claims 63-65 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kwan-Gett.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 25) and the Supplemental Answer (Paper No. 29) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 24) and the Reply Brief (Paper No. 26) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

All of the rejections are under 35 U.S.C. § 102. The guidance provided by our reviewing court with regard to the matter of anticipation is as follows: Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). The law of anticipation does not require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

The Rejection On The Basis Of Lazarus

We agree with the examiner that claim 21 is anticipated by Lazarus, which is directed to an artificial graft, on the basis of the reasoning set forth by the examiner on pages 2 and 3 of the Supplemental Examiner's Answer (Paper No. 29). We emphasize that while the Lazarus springs may be formed and may function in a manner different from the springs of the appellant's invention, the language of claim 21 reads on the embodiment shown in Figure 3, which is all that is necessary to form the basis for anticipation. The appellant's only argument with respect to this rejection of claim 21 is that the Lazarus springs are not "folded," a conclusion with which we do not agree. The common applicable definition of "folded" is "to become doubled or pleated."¹ While they may have been bent to do so, the Lazarus springs nevertheless are "folded" at 62.

This rejection of claim 21 is sustained.

The appellant has chosen to group claims 24, 25 and 28 with claim 21 (Brief, page 7), and thus they fall therewith.

Claim 22 states that "said second pair of loops are arranged to avoid occlusion of the renal arteries when said prosthesis is positioned in the abdominal aorta." We agree with the examiner that this is a statement of intended use, inasmuch as it does not add a structural limitation to the prosthesis. Moreover, the claim does not, as the appellant apparently believes, require that the ends of the graft and the springs describe a

¹See, for example, Webster's New Collegiate Dictionary, 1973, page 445.

configuration that has loop-like void areas such as are shown in Figure 5; it merely recites that the prosthesis be so positioned as to "avoid occlusion" of the renal arteries, which in our view can be accomplished by proper positioning of the Lazarus prosthesis. We therefore will sustain this rejection of claim 22.

Claim 23 adds to claim 21 the requirement that the diameter of the graft be less than the unfolded diameter of one of the springs. Lazarus teaches that the diameter of the unfolded staples (springs), that is, the diameter when in their operating configuration, "will be generally the same as" the diameter of the graft (page 8, lines 10 and 11). This being the case, the diameter of the graft is not less than that of the unfolded springs, and Lazarus does not anticipate the limitation recited in claim 23. We will not sustain this rejection.

The Rejection On The Basis Of Robinson

This rejection also applies to claims 21-25 and 28. We agree with the examiner that claim 21 is anticipated by Robinson for the reasons explained on pages 4 and 5 of the Supplemental Answer, noting that the definition of "folded" is met by the Robinson springs at 37 of Figure 4.

This rejection of claims 22, 24, 25 and 28 is sustained on the same bases as were set forth above with regard to the rejection on the basis of Lazarus.

Robinson teaches that the diameter of the unfolded (freely expanded) spring (anchor 30) be greater than that of the graft (column 8, lines 13-17), the feature which is added to claim 21 by claim 23. This rejection of claim 23 therefore is sustained.

The Rejection On The Basis Of Kwan-Gett

Independent claims 63 and 65, and dependent claim 64, stand rejected as being anticipated by Kwan-Gett. Both of the independent claims require that there be a ring "comprising a bundle of overlapping windings formed of a strand of resilient wire." The examiner has taken the position that this reads on Kwan-Gett's circular stents 18 and 20, which "preferably comprise lengths of thin, flat spring material . . . that are concentrically wound into torsion springs, similar to a watch or clock spring" (column 5, lines 20-24), because the appellant has not provided a special definition of wire which would exclude such an element. We do not agree that the Kwan-Gett lengths of flat spring material fall within the definition of "wire,"² and we will not sustain the rejection of claims 63-65.

CONCLUSION

The rejection of claims 21, 22, 24, 25 and 28 as being anticipated by Lazarus is sustained.

The rejection of claim 23 as being anticipated by Lazarus is not sustained.

²Metal in the form of a flexible thread or slender rod. See, for example, Webster's New Collegiate Dictionary, 1973, page 1345.

The rejection of claims 21-25 and 28 as being anticipated by Robinson is sustained.

The rejection of claims 63-65 as being anticipated by Kwan-Gett is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS
Administrative Patent Judge

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

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JEFFREY V. NASE
Administrative Patent Judge

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